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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/647,116	08/25/2003	Kevin RJB Donovan	16113-0633001	9849

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EXAMINER	
ALVAREZ, RAQUEL	
ART UNIT	PAPER NUMBER
3688	

NOTIFICATION DATE	DELIVERY MODE
12/03/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

Office Action Summary	Application No.	Applicant(s)	
	10/647,116	DONOVAN ET AL.	
	Examiner	Art Unit	
	Raquel Alvarez	3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11/03/2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10,12-21,31-69 and 71-73* is/are pending in the application.

4a) Of the above claim(s) *19-21 and 31-65* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10, 12-18, 66-69, 71-73* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This office action is in response to communication filed on 11/3/2009.

2. Claims 71-73 have been added.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Based on Supreme Court precedent [1] and recent Federal Circuit decisions, a 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. [2] If either of these requirements is met by the claim, the method is non a patent eligible process under § 101 and should be rejected as being directed to non-statutory subject matter.

Claim 73 is rejected under 35 U.S.C. 101 as drawn to a non-statutory subject matter. The applicant is reciting only method steps such as "identifying…ranking…storing…receiving…transmitting", the applicant has not recited an apparatus or device to perform these limitations and without apparatus or device these limitations are just mental steps. Mentioning computer in the preamble is not enough, if the body of the claims each of the steps can be performed manually.

In claim 73 the steps are related to a mental process, which is not patentable. Indeed, it is not tied to another statutory class or does not change or switch statutory

class (such as a particular apparatus or physical module or device) or does not transform the underlying subject matter (such as an article or materials) to a different state or thing. See MPEP §2106.IV.B: *Determine Whether the Claimed Invention Falls Within An Enumerated Statutory Category.*

Examiner suggests applicant inserts a device in one or more of the essential steps of the body of the claims in order to overcome this rejection.

[1] Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876).

[2] The supreme court recognized that this test is not necessary fixed or permanent and may evolve with technological advances. Gottschalk v. Benson, 409 U.S. 63,71 (1972)

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-10, 12-18, 66-68, 71-73 are rejected under 35 U.S.C. 102(b) as being anticipated by Kay (WO 00/38074 hereinafter).

With respect to claims 1, 9, 68, 71-73 Kay teaches a computerized system for generating an advertisement grouping comprising a first plurality of advertisements based on advertisement rankings associated with the first plurality of advertisements (i.e. determining view-ups based on bids)(Figure 1);

storing the advertisement in association with a network-based locator as being an up-to-date advertisement grouping for a specific distribution subject (see 16A);

generating a modified advertisement comprising a second plurality of advertisements if the advertisement rankings change as compared to the advertisement rankings on which the generation of the advertisement was based (i.e. as new view-up advertisement become available, the system compares the new view-up to other bids in order to select the highest bids)(see Figure 3A and page 16, lines 2-5);

storing the modified advertisement in association with the network-based locator as being the up-to-date advertisement for the specific distribution subject; receiving a request for an advertisement associated with the network-based locator; and in response to receiving the request, transmitting the up-to-date advertisement grouping stored in association with the network-based locator (see Figure 3B).

With respect to the newly amended limitation, Kay teaches image receiving means for receiving a request for the advertisement image associated with the network-based locator for inclusion in an electronic document and advertisement image generation including ranking means for generating advertisements ranking/ re-raking and storing the highest ranked advertisements and the modified advertisements image (i.e. inserting the new ads images for inclusion on the website, based on the ranking and storing the advertisement image in order for later display)(see Figures 3A, 3B and page 16, lines 2-5);

With respect to claims 2, 4, 6-8, 10-18, Kay further teaches a bid representing an amount to be paid for click-throughs by end-user recipients to target site associated with the advertisement (i.e. advertisers entering a "bid" which is the amount of money that the advertisers pay when a user clicks on their listing)(page 12, lines 18-24 and page 14, lines 5-7).

With respect to claims 3, 5 Kay further teaches grouping advertisements based on the highest revenue efficiency (page 14, lines 9-20).

With respect to claims 66-67, Kay further teaches the advertisements are identified in corresponding portions of the graphical image by an HTML image map (see page 7, lines 22-24).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 69 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kay in view of Official Notice.

Claim 69 further recites that the electronic document is an email. Official Notice is taken that it old and well known for electronic documents to be in the form of e-mail in order to allow recipients to view the electronic information when they please. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the electronic document being email in order to obtain the above mentioned advantage.

Response to Arguments

7. Applicant's arguments filed 11/3/2009 have been fully considered but they are not persuasive.

8. Applicant argues that Kay doesn't compare any rankings for changes in the advertisements ranking and do not generate any advertisement image if they are changes in the rankings. The Examiner disagrees with Applicant because in Kay the view-ups are ranked according to the highest bidder, the highest bidder will be ranked first (step 305) and then the second and subsequent advertisements images will be ranked or modified accordingly based on their ranking or bids in proportion to the other advertisements. If they are changes to bids or ranking, for example new view-op or the like (step 303) then the advertisements images are changed or modified accordingly (see Figures 3A-3B).

9. Applicant argues that in Kay the advertisements selected are based on bids and click-through rates and doesn't teach or suggest transmitting the advertisement the modified image store in association with the network-based locator in response to the

request for inclusion in the electronic document. The Examiner disagrees with Applicant because in Kay the first process of selecting the advertisements are based on bids, the bids determining the ranking of the advertisements and selecting the modified image from database 16A to browser 11 (block 215) in order to be placed on the web page 14 (electronic document) of web site 14 (network-based locator). Although Kay has additional steps and embodiments which includes looking at the results achieved at each site where an advertisement was previously displayed and the results achieved are examined, Applicant is reminded that *in re Bozek*, 163 USPQ 545 (CCPA 1969) AReference disclosure must be evaluated for **all that it fairly suggests** and not only for what is indicated as preferred.

10. With respect to With respect to the Official Notice taken on the electronic document being in the form of an email, The Examiner has provided examples of the well known facts and Appellant hasn't provided a proper challenge that would at least cast reasonable doubt that the known facts weren't known prior to Applicant's invention. See MPEP 2144.03. To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the Examiner's action, which would include stating **why** the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b) see also *Chevenard*, 139 F.2d at 713, 60 USPQ at 141 ("[I]n the absence of any demand by Appellant for the Examiner to produce authority for his statement, we will not consider this contention."). A general allegation that the claims define a patentable invention without any reference to the Examiner's assertion of Official notice would be inadequate").

Point of contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert A. Weinhardt can be reached on (571)272-6633. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Raquel Alvarez/
Primary Examiner, Art Unit 3688

Raquel Alvarez
Primary Examiner
Art Unit 3688

R.A.
11/30/2009